

REMARKS

The Examiner has rejected Claims 1 and 2 under the non-statutory doctrine of double patenting. Specifically, the Examiner alleges that Claims 1 and 2 of USPN 6,633,903 contains every element of Claims 1-22 of the instant application. Submitted herewith is a terminal disclaimer that renders the present rejection moot.

The Examiner has further rejected Claims 1-22 under 35 U.S.C. 103(a) as being unpatentable under Egger et al. (USPN 6,233,571) in view of Reed et al. (USPN 6,088,717). Applicant respectfully disagrees with this rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

With regard to the first element of the *prima facie* case of obviousness, the Examiner argues that it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate updating of data (objects), taught by Reed, in to the database display system, taught by Egger. Applicant respectfully disagrees with this proposition, especially in view of the vast evidence to the contrary.

For example, Egger relates to a computer search system, while Reed relates to a data communication system. To simply glean features from a data communication system, such as that of Reed, and combine the same with the *non-analogous art* of computer search

systems, such as that of Egger, would simply be improper. Data communication systems provide communication among different computing entities, while computer search systems provide search services.

"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) In view of the vastly different types of problems a computer search system addresses as opposed to a data communication system, the Examiner's proposed combination is inappropriate.

Thus, applicant respectfully asserts that the first element of the *prima facie* case of obviousness has not been met.

With respect to the third element of the *prima facie* case of obviousness (and each of the independent claims), the Examiner relies on col. 29, line 3 – col. 31, line 33 and col. 32, lines 10-21 from Egger to make a prior art showing of applicant's claimed "wherein a closed representation of said meta-folder is depictable on said display unit, said closed representation being selectable and open able with said selection unit; and further wherein an open representation of said meta-folder is also depictable on said display unit, said open representation of said meta-folder including representations of said current instances of the conventional objects" (see this or similar, but not identical, language in each of the originally-filed independent claims). Applicant respectfully disagrees with this assertion.

Specifically, Egger discloses a "Tear-Off Window feature" including "four Tear-Off Window active boxes" that "open up the full text," "run any of the three searches," "hide [a] search window," and "bring [a] search window to the foreground," respectively. However, the "Tear-Off Window feature" of Egger does not allow for opening of a "meta-folder" wherein the opened meta-folder contains instances of conventional objects, but

instead simply allows for the expansion of text, the ability to run searches, and the ability to alter the visibility of windows. Only applicant teaches and claims a meta-folder with such specifically claimed functionality.

Further, the Examiner goes on to admit that Egger does not specifically disclose a search object for locating current instances of the conventional objects. Moreover, the Examiner relies on Reed's disclosure of updating information on a consumer computer with information from a provider computer (see col. 8, lines 6-44; and col. 30, lines 14-67) to make a prior art showing of applicant's claimed "search object." Applicant respectfully disagrees with this assertion.

Clearly, the Examiner has failed to take into consideration the full weight of applicant's claimed "search object" in making such a comparison. Applicant's claimed "search object locates current instances of the conventional objects" (emphasis added), whereas Reed simply suggests updating information. Only applicant teaches and claims such a search object, in the specific context of the remaining claim limitations.

Thus, applicant respectfully asserts that the third element of the *prima facie* case of obviousness has not been met, since the references, when combined, fail to teach or suggest all the claim limitations noted above. A notice of allowance or a specific prior art showing of each of the foregoing limitations, in combination with the remaining claim elements, is respectfully requested.

Applicant further asserts that the Examiner's application of the prior art to applicant's dependent claims is also replete with deficiencies. Just by way of example, regarding dependent Claim 5, arguments similar to those above may be made concerning the failure of the Examiner to adequately provide a prior art showing of applicant's claimed "search object," let alone a "search object [that] is provided as a file and may be freely transferred and stored within said computer system," as claimed.

Regarding dependent Claim 6, applicant claims “wherein said display unit depicts using non-visual representations.” The Examiner relies on Egger’s disclosure of nodes (see col. 12, line 40 – col. 13, line 50), as well as col. 18, lines 19-55 from Reed, to make a prior art showing of applicant’s claimed “non-visual representations.” However, it appears that the Examiner has overlooked Egger’s disclosure of “[a] node [that] is any entity that can be represented by a box on a display such as a GUI” (see col. 12, lines 40-41). Such a box simply does not meet applicant’s claimed “non-visual representations,” and further *teaches away* from any sort of non-visual representation.

As mentioned previously, the Examiner further relies on Reed’s disclosure of “elements” (see col. 18, lines 19-55) to make a prior art showing of applicant’s claimed “non-visual representations” (note Claim 6). Reed, in particular, discloses “[a]n element might be a phone number, a postal address, an e-mail address, a text field, and so on” (emphasis added – see col. 18, lines 31-32). Thus, clearly, the Examiner has failed to make a specific prior art showing of applicant’s “non-visual representations,” as claimed. Indeed, Reed’s disclosure of a text field would seem to suggest, on the contrary, that such elements would be represented visually.

Regarding dependent Claim 9, applicant claims “wherein said selection unit is an automated process.” The Examiner simply fails to provide a sufficient prior art showing of a selection unit that is an automated process. The Examiner proposed combination of references disclose a “Tear-Off Window feature” (see col. 29, line 3 – col. 31, line 33 from Egger) and an “update association rule” (see col. 30, lines 14-67 from Reed), neither of which even suggest a “selection unit that is an automated process” (emphasis added).

Again, applicant respectfully asserts that the third element of the *prima facie* case of obviousness has not been met, since the references, when combined, fail to teach or suggest all the claim limitations noted above. A notice of allowance or a specific prior art showing of each of the foregoing limitations, in combination with the remaining claim elements, is respectfully requested.

Applicant further brings the Examiner's attention to applicant's added Claims 23-91, which include subject matter presented for full consideration by the Examiner.

Reconsideration and a notice of allowance are respectfully requested.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. Applicants are enclosing a check to pay for the added claims. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. MNKYP0011A).

Respectfully submitted,

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